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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/656,686	09/04/2003	Thomas J. Friedman	SP03-107 (WJT003-0045)	8554
22928	7590	01/18/2006	EXAMINER	
CORNING INCORPORATED			IVEY, ELIZABETH D	
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CORNING, NY 14831			ART UNIT	PAPER NUMBER
			1775	
DATE MAILED: 01/18/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/656,686	Applicant(s) FRIEDMAN ET AL.	
	Examiner Elizabeth Ivey	Art Unit 1775	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 11-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 17-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>22 August 2005</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

Claim 8 is objected to because of the following informalities: the word “layer” in line 4 of the claim is misspelled as “later”. Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-2, and 6-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over European Patent Application 0311425 A2 to Barger.

Regarding claims 1-2 and 6, Barger discloses masking of both sides of a polycarbonate film with non-embossed, removable, polyethylene film (column 1 lines 21-28 and 33-34) and further discloses that these films may also be applied to glass surfaces (column 4 lines 35-37) as a protective coating during shipping (column 1 lines 6-11). Barger also discloses a one sided matte embossed film with an irregular pattern which is applied to the same surfaces in order to mechanically prevent slip (column 4 lines 21-28). Because the films are used for the same purpose, it would have been obvious to a person having ordinary skill in the art at the time of the invention to utilize the embossed film as either the top or as both top and bottom surface coatings in order to protect and prevent mechanical slip of glass sheets during shipping.

Regarding claim 7, Barger discloses all of the limitations of claim 6 and discloses an irregularly patterned (rough) film (column 4 lines 21-28) with a random matte, which would result in the embossed features on the top film having different positions from the embossed features on the bottom film, so as to create air entrapment without the film layers adhering to one another (column 4 lines 55-61).

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Claims 8-10 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over European Patent Application 0311425 A2 to Barger in view of U.S. Patent 6,139,967 to Tozuka et al.

Regarding claims 8, 9 and 25, Barger discloses a removable (column 1 lines 33-34) multilayer structure that has two layers, a smooth layer and a (rough) matte layer (column 3 lines 24-37) that is applied to glass (column 4 lines 35-37) with the base layer, which would be against the glass, being the smooth layer. Barger also discloses a one sided matte embossed film with an irregular pattern which is applied to the same surfaces in order to mechanically prevent slip (column 4 lines 21-28). It would have been obvious to a person having ordinary skill in the art at the time of the invention to utilize the embossed films as either the top or as both top and bottom surface coatings in order to protect and prevent mechanical slip of glass sheets during shipping. Barger does not disclose a film wherein the smooth layer is a polymer film and the rough layer is a layer of fabric or paper. However, Tozuka discloses a removable clinging sheet, which is made from layers such as paper and a polyethylene resin (column 2 lines 35-45). Because Tozuka discloses these materials as used for a removable laminate for a glass sheet (column 1 lines 5-8) as in Barger, it would have been obvious to a person having ordinary skill in the art at the time of the invention to create the embossed sheets of Barger with the materials of Tozuka to create a protective film having an embossed (rough) paper layer and a polyester smooth layer to use as a removable laminate for a glass sheet.

Regarding claim 10, Barger and Tozuka disclose all of the limitations of claim 9. Because the prior art exemplifies the applicant's claimed material composition in relation to the

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protective film, the claimed physical property relating to the modulus of stiffness of the layers is inherently present in the prior art. Therefore, the addition of the claimed physical property to the claim language fails to provide patentable distinction over the prior art *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 *MPEP 2112.01*.

Claims 17-21, are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 2,556,529 to Farrell in view of European Patent Application 0311425 A2 to Barger.

Regarding claims 17-21, Farrell discloses a protecting container for fragile and breakable articles such as glass, and particularly a shipping carton for glass sheets; which would include glass sheets used in a liquid crystal display (column 1 lines 1-4). Farrell discloses the carton to be preferably of rectangular formation and composed of four side walls, a top and a bottom (column 2 lines 24-29) and glass sheets mounted next to each other within the carton (column 2 line 41-44 and figure 3) and discloses a method of protecting the glass sheets supporting them from breakage or damage (column 2 lines 54-55 and column 3 line 1). Farrell does not disclose removable protective films on the top and bottom of the glass sheets. Barger discloses masking of both sides of a polycarbonate film with non-embossed, removable, polyethylene film (column 1 lines 21-28); which is a flexible polymer film material as well as a polyolefin and further discloses that these films may also be applied to glass surfaces (column 4 lines 35-37) as a protective coating during shipping (column 1 lines 6-11). Barger also discloses a multilayered film comprising a film matte embossed with an irregular pattern on one side, which may be

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applied to the glass sheet surfaces in order to mechanically prevent slip (column 4 lines 21-28).

It would, therefore, have been obvious to a person having ordinary skill in the art at the time of the invention to utilize the protective films arranging the randomly embossed film as the top surface coating of the glass sheet or alternatively as the films on both the top and bottom surfaces of the glass sheet in order to protect and to prevent mechanical slip of the glass sheets during shipping. Because of the random matte with an irregular pattern, the embossed features would be located in different positions on either side of the glass sheet.

Claims 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over European Patent Application 0311425 A2 to Barger.

Regarding claims 22 and 23, Barger discloses masking of both sides of a polycarbonate film with non-embossed, removable, polyethylene film (column 1 lines 21-28) to form a protective coating for use during shipping (column 1 lines 6-11). Barger also discloses a one sided a irregularly patterned matte embossed film which is applied to the same surfaces in order to mechanically prevent slip (column 4 lines 21-28). It would have been obvious to a person having ordinary skill in the art at the time of the invention to utilize the embossed film as either the top or as both top and bottom surface films in order to protect and mechanically prevent slip of glass sheets during transportation or shipping.

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Regarding claim 24, Barger discloses a film with a random matte, which when applied to both top and bottom sides of a material, would result in the embossed features on the top film having different positions from the embossed features on the bottom film, so as to create air entrapment without the film layers adhering to one another (column 4 lines 55-61).

Response to Arguments

The examiner acknowledges Applicant's affirmation of election of claims 1-10 and 17-21, cancellation of claims 3-5 and 11-16 amendment of claims 1-2, 6-8,10,17-20, and 22-24 and addition of new claim 25.

The examiner withdraws the objection to claim 20.

Applicant's arguments filed September 15, 2005 have been fully considered but they are not persuasive.

Regarding applicant's argument that Barger does not disclose patterned embossed features; the examiner finds that Barger does in fact refer to the irregular matte as an irregular pattern. Upon further consideration, examiner submits that any matte would constitute a pattern

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of some sort whether regular or irregular as disclosed by Barger. Therefore the added limitation of a pattern does not provide a patentable limitation.

Regarding applicant's argument that Barger does not disclose patterned embossed features having a different shape or being in a different position, the random matte would assure the different positioning of the embossed features on the top and bottom protective films.

Regarding amended claims 17 and 22, applicant's argument that reference's embossed features would not perform the intended function are not persuasive. Applicant provides inadequate support for said argument.

Regarding amended claim 8 and dependent claim 10, applicant's argument that the claimed materials are not disclosed is not persuasive. The reference does indeed disclose the claimed materials as cited. However, amendment of claim 8, specifically the express positioning of the film layers in the last two lines of the claim, necessitates a new rejection. Therefore, examiner withdraws rejection of claims 8-10 as being unpatentable over Barger in view of Akao in response to the amendment and amended claims 8-10 are addressed in the 35 U.S.C. 103 rejection above.

Added claim 25 is addressed in the 35 U.S.C. 103 rejection above.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth Ivey whose telephone number is (571) 272-8432. The examiner can normally be reached on 7:00- 4:30 M-Th and 7:00-3:30 alt. Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Jones can be reached on (571) 272-1535. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Elizabeth D. Ivey


DEBORAH JONES
SUPERVISORY PATENT EXAMINER